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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,832	12/19/2001	Robert Arnold	688-266	4239

7590 07/17/2003
SOFER & HAROUN, L.L.P.
Suite 910
317 Madison Avenue
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EXAMINER

DRUAN, THOMAS J

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



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Office Action Summary

Application No.

10/025,832

Applicant(s)

ARNOLD, ROBERT

Examiner

Thomas J. Druan, Jr.

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 4 is objected to because of the following informalities: line 1, "where is" should likely be --wherein--. Appropriate correction is required.
2. Claim 14 is objected to because of the following informalities: line 2 of the claim says "that such that" when it should likely read --such that--. Appropriate correction is required.
3. Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 15 does not concern any structure with regards to the clip of claim 1, but instead only refers to the punch tool which is not claimed as being part of the present invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 refers to a "position guide for aligning a punch tool relative to a feature on the sheet media." It is not clear if or how this position guide differs from the guide edge of claim 1 since the guide edge is used to position the

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sheet media to be punched. What further alignment can the position guide provide over the guide edge? More description of the position guide is required to positively differentiate the structure from the guide edge of claim 1.

6. Claim 13 refers to "the arm" in the fourth line of the claim, though it is not clear whether "the arm" is referring to either the first or second arms of claim 1 or the extension arm in claim 13.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-9, 12 & 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US 70,586 to Mansur.

Mansur discloses the invention as claimed including a U-shaped clip comprised of first and second resilient arms **A** meeting at a connection point **B** with first and second guide edges **C** disposed angularly from said first and second resilient arms, respectively. The device of Mansur is capable of securing a punch tool between the first and second resilient arms and a sheet of media can be placed along the first guide edge such that the punch tool can punch the sheet of media. The first and second guide edges define first and second axes that meet at a right angle. The first and second guide edges have first and second guides surfaces that are capable of

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supporting a sheet media when placed in the punch tool. The connection point comprises a punch tool tab that extends from the clip so as to provide additional stability when a punch tool is fitted into the clip. A distal end of the guide edge serves as a positioning guide. The first and second guide edges are part of first and second punch tool projections that are capable of fitting into a media slot of a punch tool. To the extent the punch tool is not being claimed, it can be made of an infinite variety of designs and structures.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansur in view of US 6,457,218 to Lawrence.

Mansur discloses the invention substantially as claimed, but the device is not disclosed as being made from a plastic or a polymer. Lawrence teaches the use of a clip made of polymers/plastics in place of metal in order to provide a clip that won't corrode (column 1, lines 37-42). Therefore, it would have been obvious to one skilled in the art to make the clip of Mansur out of a polymer/plastic in order to provide a corrosion free resilient clip.

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Allowable Subject Matter

11. Claims 13 & 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mori '313 is cited to show a punch tool with an attachable corner alignment guide. Kim et al. is cited to show a punch tool having edge guides that can align either a coner or a side edge of a sheet of paper to be punched. Scribner, Winton, Broadwell, Bender, Berg, Leggett Jr., Appelbaum, Mori '529, Wang, and GB '518 are cited to show various other alignment devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Druan, Jr. whose telephone number is 703-308-4200. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

4909
tjd

May 19, 2003


Allan N. Shoap
Supervisory Patent Examiner
Group 3700